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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,051	04/08/2004	William Bornstein	AUS920030782US1(4039)	9655
45557 7590 03/24/2009 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER				
LAN, TZU-HSIANG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,051

Applicant(s)

BORNSTEIN ET AL.

Examiner

TZU-HSIANG (SEAN) LAN

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Introduction

The following is a non-final office action in response to the communications received on April 08, 2004. Claims 1-28 are now pending in this application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because claims 1-14 describe a process without an obvious tie to another statutory class. In order for a method to be considered a "process" under 35 U.S.C. 101, a claimed process must either: (1) be tied to a particular machine or apparatus or (2) transforms a particular article to a different state or thing. This is called "machine-or-transformation test." See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as a data gathering or outputting, is not sufficient to pass the test.

The method recited in claims 1-14 are neither tied to a machine nor do they transform the underlying subject to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirement of 35 U.S.C. 101 for patent eligible subject

matter. Here claims 1-14 fail to meet the above requirements because they do not present clear and meaningful tie to an apparatus. Since the applicant's method steps fail the first prong of the new Federal Circuit decision, as they are not tied to another statutory class and can be performed without the use of a particular apparatus, claims 1-14 are non-statutory.

When amending claims 1-14, applicant is reminded that nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)) incidental physical limitation, such as data gathering, field of use limitation, and post-solution activities are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

As to claims 15-20, claimed invention is directed to non-statutory subject matter. Claims 15-20 describe an apparatus with interface and database to carry out various functions. All the apparatus, interface, and database can be reasonably interpreted as software. Software application is a nonstatutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5737494 to Guinta et al. ("**Guinta**").

As to claim 1, Guinta discloses a method for improving an audit within a controlled environment (Guinta, col.1 lines 14-50), the method comprising:

determining a quality issue to address, the quality issue being associated with a product, wherein the product is the subject of the audit (Guinta, col. 1 lines 40-50 i.e. engine quality to minimize engine defect, chart 1 shows plurality of quality issues associate with a product i.e. system);

selecting a group of questions associated with the quality issue (Guinta, table 1 i.e. different group of questions associated with system quality);

posing a question of the group of questions to gather information related to evaluation of the quality issue via an interactive interface adapted for operation within the controlled environment (Guinta, Fig 5a-5e);

determining a sub-group of the group of questions, the sub-group being selected based upon an association with the information received in response to the question (Guinta, col.16 line 54 – col.17 line 21); and

storing the information (Guinta, Fig 1-3, i.e. last step corresponds to saving data or storing the information).

As to claim 2, see the discussion in claim 1 above. Guinta further discloses processing the information along with other information related to the group of questions to evaluate performance related to the quality issue (col. 17 lines 21-37, and Fig 5a-e i.e. process selected first indication with second indication to the group of questions to evaluate performance).

As to claim 3, see the discussion in claim 2 above. Guinta further discloses generating a report based upon the information to describe the performance (col. 18 lines 43 – col. 20 and table 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinta in view of US patent publication 2005/0033617 to Prather et al. ("Prather")

As to claim 4, see the discussion in claim 1 above. Guinta does not explicitly disclose interacting with a user to select the quality issue. However, Prather discloses interacting with a user to select the quality issue (Fig 12, and ¶ 42-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather since claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 5, see the discussion in claim 1 above. Guinta does not explicitly disclose selecting a quality issue based upon the product. However Prather discloses selecting a quality issue based upon the product (Prather, fig 14-15, and ¶ 51-55 i.e. select quality issue based upon product).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather since claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 6, see the discussion in claim 1 above. Guinta does not explicitly disclose searching a database for question. However Prather discloses searching a database for questions having an association with the quality issue (§ 49-53, and Fig 10-12 i.e. looking into related question database).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather since claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 7, see the discussion in claim 1 above. Guinta further discloses a relationship table for associations with the quality issue (table 1). However, Guinta does not disclose searching function to access the database. Prather discloses searching a database for information (§ 49-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather because ability to search relationship database would reduce information retrieval time.

As to claim 15, Guinta discloses an apparatus to improve an audit, the apparatus comprising:

an interactive interface (col.17 line 47-58 Fig 5a-e) to invoke a response to a question from a group of questions associated with the audit and to narrow the group to a sub-group based upon the response to the question (Fig 1-3, narrow the question based upon response).

group of questions are invoked in an order based upon the response (Fig 1-3);

However, Guinta does not explicitly disclose that the sub-group questions are relevant to a quality issue. Guinta further discloses sub-group of relevant questions in table 1 such as topics under different quality concerns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify sub-group questions based on relevancy of questions because this would optimize drill down audit questionnaire to inquire relevant features of a product.

Moreover, Guinta does not explicitly disclose a question database coupled with the interactive interface, and an audit database coupled with the interactive interface. However, Prather discloses:

a question database coupled with the interactive interface (¶ 29 and Fig. 2-3, 12), the question database having the group of questions (Fig 12 option to view all questions).

an audit database coupled with the interactive interface, to store data, wherein the data represents the response and responses to other questions from the group (¶ 86-88 and fig. 7-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather since claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 16, see the discussion in claim 15 above. Guinta does not explicitly show an audit analyzer coupled with the audit database. However, Prather further discloses:

an audit analyzer coupled with the audit database to analyze the data to evaluate performance related to the quality issue and to generate a report communicate the evaluation (fig 8, i.e. auditing database coupled to auditing server to analyze the data to evaluate performance related to quality issue in fig. 5 and report in fig. 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather since claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the

same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 17, see the discussion in claim 15 above. Guinta further disclose a relationship table (table 1) coupled with the interactive interface (Fig. 5) to describe associations between the quality issue and responses to questions of the group of questions (table 2).

As to claim 18, see the discussion in claim 15 above. Guinta further disclose a graphical user interface for a display adapted for use within a controlled environment, to interact with a user (Figure 5).

As to claim 19, see the discussion in claim 15 above. Guinta does not explicitly disclose that the question database comprises questions determined by an experienced auditor. However, Prather discloses:

Question database comprises questions determined by an experienced auditor (¶ 39-42 i.e. prepared by experts).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather because having questions determined by an experience auditor would provide standard quality audit and reduce human variability (Prather, ¶ 3-6)

As to claim 20, see the discussion in claim 19 above. Guinta further disclose that question database comprises answers to the questions (fig. 1-3, and col.6 line 42 - col.7 line 34 i.e. question database comprise scale answer and "yes" or "no" answer), but Guinta does not disclose the answers are determined by experienced auditor. However, Prather discloses:

Answers are determined by an experienced auditor (Fig. 5, and ¶¶ 39-42 i.e. weight score and possible answers in already created question bank).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guinta with Prather because having answers determined by an experience auditor would provide standard quality audit and reduce human variability (Prather, ¶¶ 3-6)

Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinta.

As to claim 8, see the discussion in claim 1 above. Guinta further displaying the question and a set of potential answers on a monitor (Fig 4 and 5). However, Guinta does not disclose displaying materials on a touch screen display of a personal digital assistant. However, official notice is taken that it was old and well known at the time of the invention to display information on a touch screen display of a personal digital assistant. It would have been obvious to one of ordinary skill in the art at the time of the invention to display auditing system on a touch screen display of a personal digital assistant because it provides more convenient information access.

As to claim 9, see the discussion in claim 1 above. Guinta further discloses selecting the sub-group for the audit in light of the information (Fig. 1-3 and col.6 line 42—line 34 i.e. demonstrable system and extent of deployment). However, Guinta does not explicitly disclose that sub-group is selected based upon relevancy of questions. Guinta further discloses sub-group of relevant questions in table 1 such as topics under different quality concerns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify sub-group questions based on relevancy of questions because this would optimize drill down audit questionnaire to inquire relevant features of a product.

As to claim 10, Guinta further discloses a method for performing an audit (Guinta, col.1 lines 14-50), the method comprising:

interacting via an interactive interface to invoke a response to a question from a group of questions associated with the audit (Figure 5 and Table 1);

narrowing the group of questions to a sub-group of the group based upon the response to the question (Fig. 1-3 and col.6 line 42—line 34 i.e. demonstrable system and extent of deployment where sub-group questions are relevant to a quality issues);
and

storing the response for analysis (Guinta, Fig 1-3, i.e. last step corresponds to saving data or storing the information, and table 2 for analysis).

However, Guinta does not explicitly disclose that sub-group questions are relevant to a quality issue. Guinta further discloses sub-group of relevant questions in table 1 such as topics under different quality concerns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify sub-group questions based on relevancy of questions because this would optimize drill down audit questionnaire to inquire relevant features of a product.

As to claim 11, see the discussion in claim 10 above. Guinta further discloses processing the response along with other responses related to the group of questions to analyze performance with respect to the quality issue (table 2, and col. 18 line 43 – col. 20).

As to claim 12, see the discussion in claim 11 above. Guinta further discloses generating a report based upon the responses to describe the performance (col. 18 lines 43 – col. 20 and table 2).

As to claim 13, see the discussion in claim 10 above. Guinta further discloses displaying a question for the audit related to the quality issue on a display adapted for operation within a controlled environment (Fig. 4-5).

As to claim 14, see the discussion in claim 10 above. Guinta further discloses identifying questions based upon the response (Fig. 1-3 and col.6 line 42—line 34 i.e. demonstrable system and extent of deployment).

However, Guinta does not explicitly disclose that the sub-group questions are relevant to a quality issue. Guinta further discloses sub-group of relevant questions in table 1 such as topics under different quality concerns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify sub-group questions based on relevancy of questions because this would optimize drill down audit questionnaire to inquire relevant features of a product.

Claims 21-22 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinta in view of U.S. Patent No. 6,272,472 B1 to Danneels et al. ("Danneels").

As to claim 21, Guinta discloses the invention substantially as claimed. See the discussion of claim 1 above. Guinta does not explicitly teach providing all these executable instructions on a computer-readable medium, although it is strongly suggested by Das in col.17 lines 38-47 i.e. memory. Danneels et al., teaches a computer-implemented method realized as one or more programs on a computer (see column 2, lines 40-46 of Danneels et al.) In addition, Danneels et al. teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see column 2, lines 46-49 of Danneels et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Guinta discussed in claim 1. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of distribution and installation and execution of the software on another computer (see column 7, lines 46-49 of Danneels et al.).

As to claim 22, see the discussion in claim 21 above. All the limitations of claim 22 are of the same scope as the limitations of claim 2 in combination with claim 3, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results

of the combination were predictable. Therefore limitations of claim 22 are rejected on the same basis as claims 2-3, and the combination is rendered obvious.

As to claim 26, Guinta discloses the invention substantially as claimed. See the discussion of claim 10 above. Guinta does not explicitly teach providing all these executable instructions on a computer-readable medium, although it is strongly suggested by Das in col.17 lines 38-47 i.e. memory. Danneels et al., teaches a computer-implemented method realized as one or more programs on a computer (see column 2, lines 40-46 of Danneels et al.) In addition, Danneels et al. teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see column 2, lines 46-49 of Danneels et al.). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Guinta discussed in claim 10. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of distribution and installation and execution of the software on another computer (see column 7, lines 46-49 of Danneels et al.).

As to claim 27, see the discussion in claim 26 above. All the limitations of claim 27 are of the same scope as the limitations of claim 11 in combination with claim 12, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the

results of the combination were predictable. Therefore limitations of claim 22 are rejected on the same basis as claims 11-12, and the combination is rendered obvious.

As to claim 28, see the discussion in claim 26 above. All the limitations of claim 28 are of the same scope as the limitations of claim 13 above, and therefore rejected on the same basis.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinta in view of Prather and further in view of Danneels.

As to claim 23, see the discussion in claim 21 above. All the limitations of claim 23 are of the same scope as the limitations of claim 5 above, and therefore rejected on the same basis.

As to claim 24, see the discussion in claim 21 above. All the limitations of claim 24 are of the same scope as the limitations of claim 6 above, and therefore rejected on the same basis.

As to claim 25, see the discussion in claim 21 above. All the limitations of claim 25 are of the same scope as the limitations of claim 9 above, and therefore rejected on the same basis.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5765138	Aycock et al.	06/9/1998
US Patent 6678129	Cambon et al.	01/6/2004
US Patent Publication 2002/0087372	Maresca et al.	07/4/2002

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TZU-HSIANG (SEAN) LAN whose telephone number is (571)270-7054. The examiner can normally be reached on Monday-Friday 8am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth V. Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/TZU-HSIANG (SEAN) LAN/
Examiner, Art Unit 3623

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